

REMARKS

This Amendment and Response is submitted in response to the Office Action mailed 28 AUGUST 2003. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

Claim Status

Claims 1-20 are pending after entry of the present amendment. Claims 1-14 stand rejected. Claims 15-20 are added herein. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Information Disclosure Statement

The Office Action Summary attached to the office action mailed 28 August 2003 indicated that a considered Information Disclosure Statement was attached to the office action. Applicant did not find an Information Disclosure Statement (PTO-1449) attached, however. Accordingly, Applicant requests a copy of the form PTO-1449 mailed 20 April 2001, marked with the Examiner's initials indicative of consideration by the Examiner.

Double Patenting

Claims 1-14 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 7 of U.S. Patent Number 6,503,207 (the '207 patent). Applicant submits herewith a Terminal Disclaimer with respect to the '207 patent, and trusts that the rejection will be withdrawn.

Claim Rejections – 35 U.S.C. §103(a)

Claims 1-2, 10, 11 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thornton (U.S. Patent Number 5,546,956).

Thornton is directed to an apparatus for testing hearing including a sound source. The sound source produces a sequence of sounds constituting a maximum length sequence (see Abstract).

In contrast, Applicant's independent claim 1 recites "stimulus generating means for transmitting at least one true random stimulus sequence to a subject's inner ear". Applicant's independent claims 10 and 14 recite "presenting at least one true random stimulus sequence to said subject's inner ear".

Applicant notes that to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art, to modify the reference teachings. Further, the cited reference (or references when combined) must teach or suggest all the claim limitations. (See M.P.E.P. §2142).

Applicant respectfully submits that there is not adequate motivation to modify the teaching of Thornton. The Examiner suggests that the motivation would be to improve audiometric testing of hearing by lessening the noise characteristics of the stimulus signal. However, "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself" In re Oetiker, 24 USPQ2d 1443,1446 (CAFC 1992). In the present application, Applicant submits that the Examiner has not pointed to any reason, suggestion, or motivation found in the art. Rather, Applicant submits that the Examiner has impermissibly found motivation in Applicant's own disclosure to modify the reference. Applicant further submits that the disclosure of Thornton teaches away from the present invention. Thornton states that "The invention thus resides in the use of a maximum length sequence (or similar sequence) to record Evoked Otoacoustic Emissions" (see Thornton, col. 1, lines 41-43). A maximum length sequence (MLS) is a quasi-random binary sequence (see Thornton, col. 1, lines 54-55). Accordingly, Thornton is directed to the use of quasi-random binary sequences, and teaches away from the use of a true random stimulus, as recited in Applicant's independent claim 1. Applicants note that "A reference which leads one away from the claimed invention cannot render the invention obvious." See Dow Chemical v. American Cyanamid, 2 USPQ 2d 1350 (Fed. Cir. 1987). Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection is improper.

Further, Applicant submits that the cited reference does not teach or disclose all limitations of Applicant's independent claim 1. The Examiner concedes that Thornton does not disclose a random stimulus (see office action, page 4). However, the Examiner states that the use of true or pure stimulus was known in the art. Applicant respectfully traverses the Examiner's taking Official Notice of this position. "It would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known" (see MPEP §2144.3). Applicant respectfully submits that the use of a true random stimulus is not a fact capable of instant and unquestionable demonstration as being well-known, and requests documentary evidence from the Examiner in the next action, should the Examiner continue to pursue the point. Applicant further submits that the Examiner has not provided any evidence of a "stimulus generating means for transmitting at least one true random stimulus sequence to a subject's inner ear" or "presenting at least one true random stimulus sequence to said subject's inner ear", as recited in Applicant's independent claims 1, 10, and 14, respectively. Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection of independent claims 1, 10, and 14 is improper, and should be withdrawn.

Claim 2 depends from and includes all limitations of Applicant's independent claim 1, and accordingly is patentable over Thornton at least for the reasons described above with regard to claim 1.

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Claim 11 depends from and includes all limitations of Applicant's independent claim 10, and accordingly is patentable over Thornton at least for the reasons described above with regard to claim 10.

Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection of claims 1-2, 10-11, and 14 over Thornton is improper, and should be withdrawn.

Claims 15-20 have been added to round out the protection to which applicant is entitled, recite certain elements of an embodiment of the inventive apparatus with particularity, and are patentable over the cited art for at least the same reasons argued relative to Claim 1 above.

CONCLUSION

Applicants submit the claims are in condition for allowance, and notification of such is respectfully requested. If after review, the Examiner feels there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,
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